

REMARKS

Claims 1-8 are currently pending in the application. Claims 1 and 5 have been amended by changing “sound” to “sound-only” to clarify that aspect of the claimed invention, which differs from the prior art in its use of sound-based rather than image-based advertising. (Specification at pages 3, line 25 – page 4, line 2) In addition, Claim 2 has been rewritten to stand in independent form by incorporation of the limitations of Claim 1 as originally presented. Finally, Claim 6 has been rewritten to stand in independent form by incorporation of the limitations of Claim 5 as originally presented. A check in the amount of \$83 is attached to satisfy the fee for one additional independent claim. No new matter has been added.

The Claimed Invention

One aspect of the claimed invention enables the distribution of advertising-funded user terminals, which may be mobile telephones and/or an Internet-connected devices, for which no fee is charged to the user. To that end, the claimed invention provides advertisement providing systems and methods which enable advertisers to gain terminal users’ attention by providing advertisements to the terminals, and upon confirming the advertisement has been heard, allowing the user to utilize the terminal as part of a no-fee program sponsored by the advertiser. In another aspect of the invention, the advertisement is in sound format only, which enables advertising to reach even terminals with low-resolution displays, such as may be used in connection with a no-fee program.

According to the claimed invention, a service providing site 10 transmits to a mobile telephone set 20 a sound advertisement data A convertible to a sound signal "a". The mobile telephone set 20 receives the sound advertisement data A, converts the sound advertisement data A to the sound signal "a", outputs the signal, and transmits an advertisement output acknowledgment signal B to the service providing site 10. The service providing site 10 receives the advertisement output acknowledgment signal B and starts to provide the service.

The Examiner has rejected Claim 2 under 35 U.S.C. § 112 as lacking a sufficient antecedent basis in the Specification. The Examiner has also rejected Claims 1, 3, 5, 7, and 8 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,647,257 to Owensby. Finally, The Examiner has rejected Claims 2, 4, 6, and 8 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,470,181 to Maxwell in view of U.S. Patent No. 5,898,904 to Wang. Applicant respectfully traverses all such rejections as discussed below.

Rejection of Claim 2 Under 35 U.S.C. § 112

The Examiner has rejected Claim 2 under 35 U.S.C. § 112, second paragraph, on the basis that “the limitation ‘a service starter for starting to provide the service’” lacks an antecedent basis in the Specification. (Office Action at 3) Applicant traverses on the basis that the Specification expressly teaches “a service starter for starting to provide the service after the advertisement output acknowledgement signal is received by the acknowledgement signal receiver.” (Specification at page 4, lines 12-15)

Applicant thus respectfully traverses and submits that there is a sufficient antecedent basis for Claim 2 in the Specification, as discussed above, and that Claim 2 should be allowed.

Rejection of Claims 1, 3, 5, 7, and 8 Under 35 U.S.C. § 102(e)

The Examiner rejected independent Claims 1, 3, 5, 7, and 8 under 35 U.S.C. § 102(e) on the basis that the claims are anticipated by Owensby. Applicant traverses on the basis that “each and every limitation of the claimed invention” is not disclosed in Owensby and because Owensby does not describe the claimed invention “sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention.” *In re Paulsen*, 31 U.S.P.Q.2d 1671, 1673 (Fed. Cir. 1994).

The Examiner admits that Owensby does not describe linking the initiation of service with the acknowledgement of receipt of advertising (Office Action at 4, discussing Claims 2, 4, 6, and 8), as in Claim 8 of the claimed invention, which depends from Claim 6. (Claim 6, lines 12-18) In addition, Applicant traverses the rejection of Claim 8 under 35 U.S.C. § 102(e) on the basis that Claim 8 depends from Claim 6, and Claim 6 has not been rejected under 35 U.S.C. § 102(e). Because the

Examiner has not found each and every limitation of Claim 6 to be disclosed by Owensby, there is no basis for concluding that each and every limitation of Claim 8 to be disclosed by Owensby.

Owensby does not describe the provision of sound-only advertisements to solve problems arising from attempts to send visual advertisements to terminals with low-resolution displays, which is a problem addressed by independent Claims 1 and 5, from which Claims 5 and 7 depend. Owensby is directed to enabling sponsors to advertise on wireless mobile communications services in order to enhance the revenues of wireless service providers, but Owensby does not consider problems associated with development of a wireless communication service that is funded by advertising rather than user subscription fees.

Applicant respectfully traverses and submits that Claims 1, 3, 5, 7, and 8 are not anticipated by Owensby, as discussed above, and should be allowed.

Rejection of Claims 2, 4, 6, and 8 Under 35 U.S.C. § 103(a)

The Examiner rejected Claims 2, 4, 6, and 8 under 35 U.S.C. § 103(a) as being unpatentable over Maxwell “as applied to claim 1 above” (Office Action at 4) in view of Wang, with Claims 2 and 6 being rejected further in view of Owensby. Applicant traverses on the basis that the rejection appears unreasonable in view of the fact that the Office Action did not apply Maxwell to the rejection of Claim 1 (the undersigned recognizes that the Examiner may have meant “Owensby”), and also on the basis that a combination of Maxwell with Wang and Owensby would not be obvious and would not result in Claims 2, 4, 6, or 8 of the claimed invention.

Maxwell describes methods and apparatuses for associating a text message with an audio message transmitted to a mobile unit in a cellular telephone network but does not describe the use of an acknowledgment signal transmitter and receiver for use in connection with the advertisement providing system or conversion of sound advertisement data into a sound signal prior to transmission of such advertisement acknowledgment signal such that reception of such acknowledgment signal causes provision of an advertising service to be started. Rather, Maxwell contemplates the advertisement being stored on the terminal device itself, and provides no means for it to be confirmed that the advertisement has been heard.

With regard to Owensby, the Examiner recognizes that Owensby does not teach “user terminal transmitting and acknowledgment signal service provider site” (Office Action at 4) and relies on Wang to make up for the deficiency. Wang, however, does not discuss advertising, as a result, there is no basis on which to conclude that it would occur to one of ordinary skill in the art to combine Wang with Maxwell or Owensby to solve an advertising problem and arrive at Claims 2, 4, 6, or 8.

As currently amended to stand in independent form, Claims 2 and 6 provide that initiation of service begins when a user terminal transmits “an advertisement acknowledgment signal to the service providing site.” (Claim 2, lines 12-13; Claim 6, lines 12-13) When the acknowledgment signal is received, “the service providing site . . . then starts to provide service.” (emphasis added) (Claim 6, lines 14-15; *see also* Claim 2, lines 14-18) Thus, Claims 2 and 6, from which Claims 4 and 8 depend, enable the distribution of advertisement-funded user terminals by linking the initiation of service to acknowledgment of the receipt of advertising. That is, the claimed invention contemplates a system and method where a user is able to utilize a communication system at no charge (the advertiser paying for the user’s use) - the only requirement is that the user must hear the advertisement before he or she can use the terminal. There is no comparable teaching or claim in Owensby, Maxwell, or Wang, either individually or in combination.

Applicant respectfully traverses and submits that Claims 2, 4, 6, and 8 are properly viewed as patentable over Maxwell in view of Wang, as discussed above, and should be allowed.

Conclusion

In view of the foregoing, Applicant submits that all of the claims are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed.

Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041 (Whitham, Curtis & Christofferson).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael E. Whitham', written over a horizontal line.

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